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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,534	04/18/2007	Sergey Popov	1561-US	2993

24505 7590 08/25/2009  
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EXAMINER
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HOLLOWAY, IAN KNOBEL

ART UNIT	PAPER NUMBER
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3763

NOTIFICATION DATE	DELIVERY MODE
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08/25/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/579,534	<b>Applicant(s)</b> POPOV, SERGEY	
	<b>Examiner</b> IAN K. HOLLOWAY	<b>Art Unit</b> 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 46-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/25/2007</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This office action is in response to application no. 10/579534 filed on 4/18/07.

#### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 46-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erskine (US Patent 5795339), herein after referred to as E, in view of Kerby et al. (US Patent 5098410), herein after referred to as K.

Regarding **Claim 1**, E discloses a catheter having a catheter hub (**11**, catheter hub) and an axial through channel with a proximal end portion made as a female luer

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lock portion; a needle assembly comprising: a needle (**20**, the needle) with a distal sharp point, which extends through said catheter channel, a safety means having a protector (**38**, the neck) for protecting said needle distal sharp point after introducing said catheter into a blood vessel, a protected position of elements of said needle assembly in which said needle is protected by said protector; (**Fig. 4**, the protected position) and

**E** fails to disclose a catheter cap for occluding a proximal opening of said catheter after the transposition of said needle to a protected position, therewith said catheter cap is detachably positioned on said needle assembly so that, after said needle protection, said catheter cap is accessible for occluding said catheter proximal opening without previous detachment of said catheter cap from said needle assembly

However, **K** teaches a catheter cap (**36**, the cap) for occluding a proximal opening of said catheter after the transposition of said needle to a protected position, therewith said catheter cap is detachably positioned on said needle assembly so that, after said needle protection, said catheter cap is accessible for occluding said catheter proximal opening without previous detachment of said catheter cap from said needle assembly

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the construction as taught by **K**, since **K** states at column 1, lines 49-53 that such modification would satisfy the need of a secure cap and adapter connection. Thus, it would have been obvious to one of ordinary skill in the art to apply

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the construction as taught in **K**, to improve the device of **E** for the predictable result of making the cap more effective.

Regarding **Claim 47**, **K** discloses: catheter cap has a sealing surface, (**36**, the cap has threadings) which provides the sealing contact with said catheter upon mounting said catheter cap onto said catheter.

Regarding **Claim 48**, **K** discloses: a mounting means for mounting said catheter cap on said needle assembly and their detaching, and said mounting means has first (**15**, the adapter input) and second (**Fig. 2**, the cap is held separate) mounting elements one of which is disposed on said needle assembly and the other on said catheter cap.

Regarding **Claim 49**, **E** discloses the invention as claimed above except for catheter cap and the detail of said needle assembly on which it is positioned are made as a single part.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device as a single element, since the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

Regarding **Claim 50**, **E** discloses: a shielding means (**30**, the barrel) preventing said sealing surface of catheter cap from accidental contact with the operator before mounting said catheter cap onto said catheter.

Regarding **Claim 51**, **E** discloses: a shielding wall (**32**, the chamber wall) enclosing said sealing surface and protruding beyond its open edge.

Regarding **Claim 52, K** discloses: catheter cap has a tapered male luer member **(36, the interior forms a male attachment)** and said sealing surface is the conical surface of said tapered male luer member.

Regarding **Claim 53, K** discloses: male luer member of said catheter cap disposed on said needle assembly is directed outwardly. **(36)**.

Regarding **Claim 54, E** discloses: a stabilizing means **(60, latch actuator)** ruling out the rotation of said sealing surface with respect to said needle assembly during mounting said catheter cap onto said catheter.

Regarding **Claim 55, E** discloses: at least one slot **(33, second chamber)** and at least one projection, **(60, latch)** one of which is located on said first mounting element and the other on said second mounting element so that said projection slidably enters said slot.

Regarding **Claim 56, K** discloses: a thread **(42, luer thread)** disposed on said first and second mounting elements.

Regarding **Claim 57, K** discloses: interacting a female conical portion **(17, the passage)** and a male conical element, **(16, the output)** one of which is disposed on said first mounting element and the other on said second mounting element.

Regarding **Claim 58, K** discloses: catheter cap is detachably retained on said needle assembly by the friction forces between said first and second mounting elements. **(Fig. 2, the connection)**.

Regarding **Claim 59**, **E** discloses: after protecting said needle distal sharp point with said safety means, said needle assembly has a proximal end and a distal end, and said catheter cap is positioned at one of said needle assembly ends. (**Fig. 4**).

Regarding **Claim 60 and 61**, **K** discloses: catheter cap is disposed on said protector. (**Fig. 2**, the cap can be placed on the protector) or a hub of said needle. (**Fig. 2**, the cap is found on the hub).

Regarding **Claims 62-66**, **E**, disclose the invention claimed as seen from rejections 46-61.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brimhall (US Patent 5879334).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IAN K. HOLLOWAY whose telephone number is (571)270-3862. The examiner can normally be reached on 8-5, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas D. Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ilan K Holloway/  
Examiner, Art Unit 3763

/Nicholas D Lucchesi/  
Supervisory Patent Examiner, Art Unit 3763